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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,485	10/29/2003	Roger L. Beavers	4280-016	6982
4678	7590	03/08/2005	EXAMINER	
MACCORD MASON PLLC 300 N. GREENE STREET, SUITE 1600 P. O. BOX 2974 GREENSBORO, NC 27402			TA, THO DAC	
			ART UNIT	PAPER NUMBER
			2833	

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/696,485	Applicant(s) BEAVERS ET AL.	
	Examiner Tho D. Ta	Art Unit 2833	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 20-23 is/are pending in the application.
- 4a) Of the above claim(s) 10, 11 and 20-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 9 is/are rejected.
- 7) ☒ Claim(s) 6-8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/29/04</u> . | 6) <input checked="" type="checkbox"/> Other: <u>Sheet 1 of 3 of US 5,562,491</u> |

DETAILED ACTION

Election/Restrictions

1. Claims 9 and 10 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 12/6/04.
2. Further restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-9, drawn to an improved gel-protected registered telephone jack, classified in class 439, subclass 521.
 - II. Claims 20-23, drawn to a method of making an improved gel-protected registered jack, classified in class 264, subclass 500+.
3. The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the telephone jack housing can be made by another and materially different process other than molding.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Mr. Robert W. Glatz on 03/02/05 a provisional election was made with traverse to prosecute the invention of I, claims 1-9. Affirmation of this election must be made by applicant in replying to this Office action. Claims 20-23 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Objections

7. Claim 8 is objected to because of the following informalities: claim 8, line 1, the recitation "the bar" lacks antecedent basis. For purpose of examination, Examiner assumes that claim 8 is depend from claim 7. Appropriate correction is required.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 3-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Shimirak et al. (5,562,491).

In regard to claim 1, Shimirak et al. discloses an improved gel-protected registered telephone jack 10 of the type including a housing 20, a cavity in the housing 20, a rear opening in the housing 20 communicating with the cavity to permit positioning of an insert (see attached drawing) that connects permanent telephone wires 45 to spring connectors 40, a front opening in the housing communicating with the cavity to receive a plug 50 so as to make contact between wires 45 in the plug 50 and the spring connectors 40 with a gel 70 on the spring connectors 40 to prevent corrosion of the connectors 40, the improvement comprising: a retainer 30 to bind the insert to the housing 20 and thereby limit fore-and-aft translational movement of the insert within the cavity.

In regard to claim 3, Shimirak et al. discloses that the retainer 30 is installed to the rear of the insert.

In regard to claim 4, Shimirak et al. discloses the retainer 30 provides access (the opening in 30 where wires 45 go through) to the rear end of the insert.

In regard to claim 5, the recitation that "the registered jack is selected from the group consisting of RJ11, RJ11C; RJ11IW; RJ14C; RJ14W; RJ25C; RJ31X; RJ38X', RJ45S; RJ48C; RJ48S; RJ48X; and RJ61X" has not been given a significant patentable weight because it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 2 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimirak et al..

In regard to claim 2, Shimirak et al. does not disclose that the retainer 30 is installed by a permanent fastening process.

Official Notice is taken that both the concept and the advantages of providing a permanent fastening which include the adhesive are well known and expected in the art.

In regard to claim 9, Shimirak et al. does not disclose that the retainer 30 is ultrasonically welded to the insert and the housing.

Official Notice is taken that both the concept and the advantages of providing an ultrasonically welded are well known and expected in the art.

Allowable Subject Matter

12. Claims 6-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


13. The following is a statement of reasons for the indication of allowable subject matter: the prior art fails to provide, teach or suggest the retainer includes a bar having two ends extending across the rear opening and having two ends rigidly joined to the housing and a portion of the bar between the two ends rigidly joined to the insert.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tho D. Ta whose telephone number is (571) 272-2014. The examiner can normally be reached on M-F (8:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula A. Bradley can be reached on (571) 272-2800 ext 33. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


THO D. TA
PRIMARY EXAMINER